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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/939,072	08/24/2001	Gregory M. Fehn	09798495-0030	4249

26263 7590 09/30/2004

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EXAMINER

NOLAN, SANDRA M

ART UNIT PAPER NUMBER

1772

DATE MAILED: 09/30/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

09/939,072

**Applicant(s)**

FEHN, GREGORY M.

**Examiner**

Sandra M. Nolan

**Art Unit**

1772

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 20 July 2004.  
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-49 is/are pending in the application.  
4a) Of the above claim(s) 23-49 is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☒ Claim(s) 1-22 is/are rejected.  
7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.  
10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.  
4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_.  
5) ☐ Notice of Informal Patent Application (PTO-152)  
6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Claims***

1. Claims 1-49 are pending. Claims 23-49 have been withdrawn.

### ***Allowability/Objection Withdrawn***

2. The allowability of and objection to claims 4-9 is hereby withdrawn in order to apply the new grounds of rejection below.

### ***Rejections Withdrawn***

3. The 35 USC 112 rejection of claim 3 is hereby withdrawn in order to apply the new grounds of rejection below.
4. The 35 USC 102 rejection of claims 1-3 and 10-22 as anticipated by Fehn (US 5,693,283) is hereby withdrawn in order to apply the new grounds of rejection below.

### ***New Rejections***

#### ***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1-3, 10-12, 14-17, 19 and 22 are rejected under 35 U.S.C. 102(b) as being anticipated by Mehta (US 4,880,675).

Mehta teaches containers with polypropylene outer layers, oxygen barrier layers of EVON or nylon as intermediate layers and fluorinated polyethylene inner layers (see the abstract and claims 1-6 of the patent). The containers are blow molded, injection

Art Unit: 1772

molded and thermoformed (col. 2, lines 14-18). The polyethylene is only 0.05 to 10 mils thick (claim 1 of the patent) because it cannot withstand high hot fill temperatures (col. 2, line 55). There may be barrier coatings on the exterior and interior of the containers (col. 3, lines 62-65). The containers may hold aqueous methanol/limonene solutions (col. 4, lines 65-69).

The solutions described in col. 4 are deemed comestibles and chemicals.

***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

9. Claim 1-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mehta.

Mehta is discussed above.

Art Unit: 1772

It fails to teach the amount of polypropylene recited in claims 4-6 and 8, the gloss layers of claims 7-8, and the adhesive layers as intermediate between the polyethylene and polypropylene layers.

In the absence of convincing objective evidence to the contrary, it would have been a matter of engineering choice to limit the amount of polyethylene used, employ several adhesive layers and employ glossy outer layers in the containers of Mehta.

The motivation to limit the amount of polyethylene is found at col. 2, lines 51-56 of Mehta, where polyethylene is said to be unable to withstand hot fill temperatures.

The motivation to employ several adhesive layers would be based on a desire to insure interlayer adhesion.

The motivation to make the outer layer glossy is based upon a desire to make the container more attractive.

It is deemed desirable to make containers that can be readily hot filled, have good interlayer adhesion and are attractive to consumers.

### ***Double Patenting***

10. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Art Unit: 1772

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

11. Claims 1-22 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-21 of U.S. Patent No. 6,194,043B1 to Fehn in view of Mehta.

Fehn claims containers having a first layer of recycled polyethylene, a second layer of EVOH (claim 1) and a third layer of polypropylene (claim 4). The use of several tie layers between the olefin layers and the EBOH layer is claimed in claim 11. The use of reground scrap is recited in claim 12. The use of blow molding, thermoforming and injection molding is recited in claims 18, 19 and 20, respectively.

Fehn fails to claim the use of thin layers of polyethylene or fluorinated polyethylene.

Mehta teaches that polyethylene should be used in minimal amounts because it cannot withstand hot fill temperatures. At col. 2, lines 51-56 of Mehta teaches polyethylene to be unable to withstand hot fill temperatures. Mehta teaches fluorinated polyethylene inner layers (see the abstract and claims 1-6 of the patent) as having barrier properties (col. 3, lines 33-36).

The patents are analogous because they both deal with multilayer containers having polyethylene and polypropylene layers.

It would have been obvious to one having ordinary skill in the art at the time of the invention to employ the thinner, fluorinated polyethylene inner layers of Mehta in the

Art Unit: 1772

containers of Fehn in order to keep the hot fill properties assured by thinner polyethylene layers and the barrier properties assured by the fluorinated polyethylene.

The motivation to employ thinner, fluorinated polyethylene inner layers of Mehta in the containers of Fehn is found at col. 2, lines 51-56 of Mehta, where the hot fill properties of polyethylene are taught, and in the abstract and claims 1-6 of the patent, where fluorinated polyethylene is taught.

It is desirable to make containers that can be filled at high temperatures and have barrier properties because of the presence of several barrier layers therein so that solutions that are prepared/maintained at higher temperatures can be stored therein.

### ***Response to Arguments***

12. Applicant's arguments with respect to claims 1-22 have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

Any inquiry concerning this communication should be addressed to Sandra M. Nolan, at telephone number 571/272-1495. She can normally be reached Monday through Thursday, from 6:30 am to 4:00 pm, Eastern Time.

If attempts to reach the examiner are unsuccessful, her supervisor, Harold Pyon, can be reached at 571/272-1498.

The fax number for patent application documents is 703/872-9306.



S. M. Nolan  
Primary Examiner  
Technology Center 1700

09939072(20040927)